

Question Q217

National Group: PORTUGAL

Title: The patentability criterion of inventive step / non-obviousness

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

The Portuguese law defines the inventive step succinctly, similarly to Germany and to article 56 of the EPC: “an invention shall be considered as involving an inventive step if, to a person skilled in the art, it is not obvious having regard to the state of the art”.

There is no specific standard for inventive step, but in Portugal the PTO and the Courts usually follow the EPO problem-solution approach.

2. Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?

In 1995 with the entry in force of a new (at the time) code of Industrial Property, the requirement of inventive step was introduced for the first time. Since then, no other change has occurred.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Yes, the Portuguese PTO publishes in its website guidelines for the examination of patents. The guidelines are very useful in assessing the novelty and inventive step patentability requirements because the law has not defined any specific test/standard for such purpose.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

No.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

During prosecution claims are read literally. In courts, claims are construed taking into account the understanding of a person skilled in the art.

6. Is it possible to read embodiments from the body of the specification into the claims?

Yes, embodiments may serve to help interpreting the claims.

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

During prosecution prior art is read literally, but combination of prior art is interpreted as it would be understood by a person skilled in the art. In court cases, prior art is interpreted as it would be understood by a person skilled in the art, being reliance on inherent disclosures admitted as well as common general knowledge.

8. Do the answers to any of the questions above differ during examination versus during litigation?

Yes, as already explained.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

It is proper but was not common until recently when some cases have started to show up. In these up to now few cases, arguments were not sufficient and other documents (from the prior art or not) pointing different directions from the readings of the single prior art reference were necessary.

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

The content of the disclosures is such as to make it likely that the person skilled in the art, when faced with the problem solved by the invention, would combine them, for example, if the disclosures come from similar or neighboring technical fields, then the combination is obvious.

Explicit teaching and motivation to combine is not required, as it would lead to obviousness.

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed? How relevant is the problem the inventor of the claim in question was trying to solve?

The closeness of the technical field to what is being claimed is very relevant and it implies a very clear indication of the problem to be solved and of the "teaching away" in order to avoid the "could-would" approach. If the combined prior art references are from distanced technical fields, the possibility of finding inventive step is greater. The relevance of the problem to be solved is not important as long as there is a problem to be solved, that can be just an alternative to a known device or process which provides the same or similar effects or is more cost-effective.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

Yes, it is possible to combine more than two prior art references. The standard may change because the need to combine more than two references may be indicia of inventive step.

13. Do the answers to any of the questions above differ during examination versus during litigation?

Yes. In our experience in the Portuguese Courts, it is very difficult to succeed in a nullity action by attacking the inventive step.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

It is advisable to clearly define a problem-solution approach. According to the "Examination guidelines" the examiner has to apply the problem-solution approach in the exam. It is not a matter of the specific technical field of the problem but a matter of determining if the solution for the defined problem comes evident from the teachings of prior art documents.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The technical problem should be identified, being such description done in such a manner that the technical problem that it addresses can be assessed and the solution can be understood by a person skilled in the art.

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

The advantageous effects play an important role in determining inventive step. An unexpected technical effect may be strong indicia of inventive step.

17. Must the advantageous effects be disclosed in the as-filed specification?

It is not mandatory but it is advisable to do so.

18. Is it possible to have later-submitted data considered by the Examiner?

Yes. Normally this can be done to substantiate the unexpected results or comparative studies evidentiating the differences from the expected teachings from the prior art.

19. How "real" must the advantageous effects be? Are paper or hypothetical examples sufficient?

Paper or hypothetical examples are not enough. They must be real.

20. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

Yes, teaching away may be considered as important indicia of inventive step. The teaching away must be explicit.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Teaching away is normally only used as a last resource to avoid obviousness.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Secondary considerations are admissible.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

Where the invention solves a technical problem existing for a long time, or fulfils a long-felt need, this might be an indication of inventive step.

Failure of others to solve the problem may serve as an indicator of inventive step. Commercial success, by itself, cannot serve as an indicator; however, if proved in conjunction with a long-existence need, it becomes relevant. The success must result from its technical characteristics and not from any other factors.

26. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

No.

If yes, please describe these issues, tests, or factors.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and , if so, provide a brief summary of such interpretation.

There is no test.

29. Does such test differ during examination versus during litigation?

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

No.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

No.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

No.

33. If yes, is this problematic?

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Yes.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

No

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

An invention shall be considered to involve an inventive step if, having regard to the prior art, the claimed solution to the objective technical problem is non-obvious for the skilled person.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

Considering the technical features not disclosed by the closest prior art, is there any teaching in the prior art, as a whole, that would (not simply could) have prompted the skilled person, to modify or adapt said closest prior art thereby arriving at something falling within the terms of the claims.

SUMMARY

Portuguese law defines inventive step as article 56 of EPC: “an invention shall be considered as involving an inventive step if, to a person skilled in the art, it is not obvious having regard to the state of the art”.

There are no provisions in law for a specific test/standard for inventive step but PTO and Courts usually follow EPO problem-solution approach.

During prosecution claims are read literally. In courts, claims are construed taking into account the understanding of a person skilled in the art and embodiments may serve to interpret the claims.

During prosecution combination of prior art is interpreted as it would be understood by a person skilled in the art. In court cases, prior art is interpreted as it would be understood by a person skilled in the art.

Advantageous effect and unexpected technical effect are strong indicia of inventive step. Also, teaching away and secondary considerations are admissible.

The Portuguese Group proposes the following definition for a universally acceptable standard for inventive step / non-obviousness:

“An invention shall be considered to involve an inventive step if, having regard to the prior art, the claimed solution to the objective technical problem is non-obvious for the skilled person”

and the following approach to the application of this definition:

“Considering the technical features not disclosed by the closest prior art, is there any teaching in the prior art, as a whole, that would (not simply could) have prompted the skilled person, to modify or adapt said closest prior art thereby arriving at something falling within the terms of the claims”.

Résumé

La loi portugaise définit l'activité inventive en accord avec l'article 56 de la CBE : « une invention est considérée comme impliquant une activité inventive si, pour un homme du métier, elle ne découle pas d'une manière évidente de l'état de la technique ».

La loi ne contient pas de dispositions pour un test/critère spécifique d'activité inventive, mais l'Institut National de la Propriété Industrielle et les tribunaux appliquent habituellement l'approche problème-solution de l'OEB.

Au cours de l'examen, les revendications sont interprétées littéralement. Durant les procédures judiciaires, les revendications sont interprétées comme elles seraient comprises par l'homme du métier et les modes de réalisation peuvent servir à interpréter les revendications.

Lors de la procédure d'examen, la combinaison de l'art antérieur est interprétée tel que le ferait l'homme du métier. Dans les procédures judiciaires, l'art antérieur est interprété comme le ferait l'homme du métier.

Les effets avantageux et les effets techniques inattendus apportent de forts indices d'activité inventive. Le préjugé vaincu et les facteurs secondaires sont également admissibles.

Le Groupe portugais propose la définition suivante pour un critère d'activité inventive / non-évidence universellement acceptable :

« une invention doit être considérée comme impliquant une activité inventive si, compte tenu de l'état de la technique, la solution revendiquée au problème technique objectif n'est pas évidente pour l'homme du métier »

et l'approche suivante pour l'application de cette définition :

« Compte tenu des caractéristiques techniques non divulguées par l'art antérieur le plus proche, existe-t-il un enseignement dans l'ensemble de l'état de la technique qui aurait motivé (et non pas simplement aurait pu motiver) l'homme du métier à modifier ou adapter ledit art antérieur le plus proche, afin d'aboutir à quelque chose tombant dans le champ des revendications ? »

ZUSAMMENFASSUNG

Portugiesischem Recht definiert erfinderischen Tätigkeit als Artikel 56 des EPÜ: "Eine Erfindung gilt als auf einer erfinderischen Tätigkeit beruhend, wenn sie sich für den Fachmann nicht in nahe liegender Weise aus dem Stand der Technik ergibt".

Es gibt keine Bestimmungen im Gesetz für einen bestimmten Test/Standard für erfinderische Tätigkeit, aber der PTO und Gerichte in der Regel folgen die EPO Problem-Lösungs-Ansatz. Während Strafverfolgung, Ansprüche sind wörtlich gelesen. Bei den Gerichten, Ansprüche sind berücksichtigt ausgelegt wobei das Verständnis von einem Fachmann in der Technik und Ausgestaltungen können dazu dienen, um die Ansprüche zu interpretieren.

Während Strafverfolgung, der Kombination aus dem Stand der Technik wird interpretiert, wie es von einem Fachmann in die Kunst verstanden wäre. In Gerichtsverfahren, der Stand der Technik ist ausgelegt, wie es von einem Fachmann in der Technik verstanden würde.

Vorteilhafte Wirkung und unerwarteten technischen Effekts sind starke Indizien der erfinderischen Tätigkeit. Auch lehren und sekundäre Überlegungen sind zulässig.

Die Portugiesische Gruppe schlägt die folgende Definition für eine allgemein akzeptable Standard für die erfinderische Tätigkeit/Nichtoffensichtlichkeit:

"Eine Erfindung gilt als auf einer erfinderischen Tätigkeit, wenn, in Kenntnis des Standes der Technik, der beanspruchten Lösung für die objektive technische Aufgabe ist nicht naheliegend für den Fachmann"

und den folgenden Ansatz bei der Anwendung dieser Definition:

"In Anbetracht der technischen Merkmale, die nicht in der nächstliegenden Stand der Technik offenbart sind, gibt es eine Lehre in den Stand der Technik, als Ganzes, das möchte (nicht nur könnte) der Fachmann abfragen, die genannte nächstliegenden Stand der Technik zu modifizieren oder anzupassen und dadurch am etwas im Sinn der Ansprüche ankommen".